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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/581,478 06/14/00 SAKAKI

Y 1241.14

EXAMINER

HM22/1003

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NEW YORK NY 10112-3801

ARTHUR, I.

ART UNIT

PAPER NUMBER

1655

DATE MAILED:

10/03/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/581,478

Applicant(s)

SAKAKI, YOSHIYUKI

Examiner

Lisa B. Arthur

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-38 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Art Unit: 1655

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1,8,22,23, drawn to a Napl polypeptide and a therapeutic composition of Alzheimer's containing the polypeptide, classified in class 530, subclass 350.
- II. Claims 2-6,20,21, drawn to a nucleic acid encoding a Napl polypeptide having the Napl function , a vector and a transformed cell, classified in class 536, subclass 23.5 and class 435, subclasses 320.1 and 325.
- III. Claims 9-15, 24-38, drawn to oligonucleotides, methods for detecting mRNA using the oligonucleotides, a method for repressing transcription using the oligonucleotides and a therapeutic composition containing the oligonucleotides, classified in class 435, subclass 6, class 536, subclass 24.31 and class 514, subclass 44.
- IV. Claims 16-19, drawn to an antibody, classified in class 530, subclass 387.1.

The inventions are distinct, each from the other because:

Inventions I-IV each contain products which are patentably distinct because the products are structurally and functionally different. The polypeptide of invention I is composed of amino acids linked by peptide bonds and arranged in a complex three-dimensional configuration. The polypeptide is able to associate with the SH3 domain of an intracellular signal trasnduction molecule Nck and can suppress apoptosis. The nucleic acid of invention II is composed of deoxynucleotide linked by phosphodiester bonds and arranged as a double helix.

Art Unit: 1655

This nucleic acid can function for the recombinant production the Nap I polypeptide or as a specific probe for the gene sequence. The oligonucleotides of invention III are also composed of deoxynucleotides but are structurally distinct from the nucleic acid of invention II because the oligonucleotides are small segments and do not encode the Nap I protein. Unlike the nucleic acid of invention II the oligonucleotides can function as primers in an amplification reaction. Finally, the antibodies, while being composed of amino acids linked by peptide bonds have a distinct tertiary structure from the Nap1 protein and can function in the specific binding and affinity purification of Nap1. Therefore, each of these products is novel and unobvious over one another.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

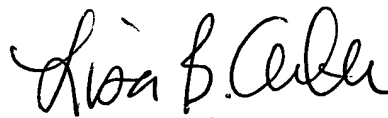
Art Unit: 1655

remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa B. Arthur whose telephone number is 308-3988. The examiner can normally be reached on Monday-Wednesday from 7:00 am to 2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for the organization where this application or proceeding is assigned is 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0196.



LISA B. ARTHUR  
PRIMARY EXAMINER  
GROUP 1800 1600  
October 1, 2001